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EXAMINER

SHIN, KYUNG H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,147

Applicant(s)

SHODA ET AL.

Examiner

Kyung H. Shin

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-29 and 31-33 is/are rejected.
- 7) ☒ Claim(s) 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/8/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is responding to application filed 8/31/2000 and Foreign priority 9/1/1999
2. Claims **1-34** are pending. **Claim 12 and 30** are canceled. **Claims 1, 16, 17, 19** are Currently Amended. **Claims 1, 16, 17 and 19** are **independent**.

Response to Arguments

3. Applicant's arguments filed 9/2/2005 have been fully considered but they are not persuasive.

Response to Remarks

- 3.1 Applicant argues that the cited prior art does not disclose that for claims 1, 16, 17, 19 “... *the process right stored in the storing of the process right specifies a number of executions, and that the displaying of the process right displays on the screens as many icons as the number of executions by the process right ...*”(see *Remarks Page 12, Lines 10-12*).

The Gregg (6,516,416) prior art discloses the capability to process copyright protection rights information and enable executions for a copyright protected product. (see Gregg col. 20, lines 34-40: storage copyright protection process

right; col. 20, lines 20-27: copyright protection process right implemented (i.e. executed), process right implemented multiple times (i.e. number of executions))

And, the Gregg (6,516,416) and Levine (5,726,883) prior art combination discloses the capability to generate a customized display screen, which contains multiple icons objects such that there exists a number of icons equal to the number of executions. (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)

3.2 The dependent claims stand rejected as articulated in the Final Office Action and all objections not addressed in Applicant's response are herein reiterated as claims of 1/21/05

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **1, 2, 11 - 17, 19, 20, 29, 30 - 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregg et al.** (US Patent No. 6,516,416) in view of **Levine et al.** (US Patent No. 5,726,883).

Regarding Claim 1, 16, 17, 19 (all Currently Amended), Gregg discloses a data processing apparatus operable to execute a process on copyrighted data within an obtained right, said apparatus comprising:

- a) a data storage unit operable to store the data; (see col. 4, lines 50-54: SQL database for the storage of the intellectual property, copyrighted, data. *"The clearinghouse consists of a structured query language (SQL) database which hosts the clearinghouse database ...which authenticates subscribers on behalf of the subscription access server ..."*)
- b) a right information storage unit operable to store a process right that is required for executing the process on the data stored in said data storage unit; (see col. 20, lines 34-40: Obtain the process rights information for a copyrighted intellectual property from the database. *"The server application reads the copyright level of protection for the contents from the content headers.....The server applications then sends the copyrighted contents to the client application ..."*)
- c) an input unit operable to input an instruction for the data stored in said data storage unit; (see col. 20, lines 53-58: Input the selection for a process right which is translated into a instructional message (a command function) forwarded to the server. *"However, if one of those options were chosen, the subclass client application recognizes the user's selection as a unique*

message ... and the subclass client application forwards the user message to the content controller".)

- d) a control unit operable to determine, based on the process right stored in said right information storage unit, whether the instruction is to be executed or not; (see col. 20, lines 1-7: Determine whether selected copyright protection instruction is to be executed or not. *"...The copyright protection instruction includes a command to implement the protection and an integer denotes the level of copyright protection that need to be implemented."*)
- e) a process execution unit operable to execute the instruction; (see col. 20, lines 20-27: After selection of copyright protection instruction, instruction is implemented (executed). *"The user must then choose which of the three options to implement. ... If the user chooses one of the three, the client application recognizes the user selection in the form of a unique message ... and which of those options is chosen is then determined (blocks 340, 342, 344) which results in activation of the particular function (block 346, 348, 350)."*)

Gregg does not disclose a display screen to display only the process rights allowable by the current user, process right specifies a number of executions, or multiple icons to represent multiple executions.

However, Levine discloses a data processing apparatus, a data processing method, and a recording medium with a program recorded therein, said program for executing, on a computer, a data processing method

operable to display allowable process rights, process right number of execution, and multiple icons for multiple executions for copyrighted data within an obtained right, said apparatus comprising:

- f) a display unit operable to display the process right stored in said right information storage unit on a screen, (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)
- g) wherein the process right stored in said right information storage unit specifies a number of executions, (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)
- h) wherein said display unit is operable to display on the screen as many icons as the number of executions specified by the process right. (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregg to ... as taught by Levine. One of ordinary skill in the art would be motivated to employ Levine in order to optimize techniques for the creation and access to customized control interfaces for users. (see Levine col. 1, lines 7-9: " ... *user interface*, in

particular, to a simplified technique of creation, storage and access to multi-level customized control interfaces ...")

Regarding Claims 2 (Currently Amended), **20** (New), **Gregg** discloses the data processing apparatus according to claim 1, further comprising data receiving unit operable to receive the data stored in said data storage unit through a communication channel, and obtain the process right stored in said right information storage unit through the communication channel. (see col. 20, lines 11-18: A user on a client system receives the copyright protected contents from the server system. *"A user requests the contents from a server application through a client or user application (block 330) which results in the server application sending the contents to the client application (block 332)."*

Regarding Claims 11 (Previously Presented), **29** (Previously Presented), **Gregg** does not disclose a display screen to display icons corresponding to the process rights allowable by the current user. However, **Levine** discloses the data processing apparatus according to claim 1, wherein said display unit is operable to display one or more icons on the screen corresponding to the process right stored in said right information storage unit. (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)

It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify Gregg to enable a display unit to display one or more icons indicating application execution as taught by Levine. One of ordinary skill in the art would be motivated to employ Levine in order to optimize techniques for the creation and access to customized control interfaces for users. (see Levine col. 1, lines 7-9: “ ... *user interface, in particular, to a simplified technique of creation, storage and access to multi-level customized control interfaces ...* ”)

Regarding Claims 13 (Currently Amended), **31** (New), Gregg discloses the data processing apparatus according to claim 1, wherein said display unit is operable to display on the screen the process right to data that can be processed in a set process mode. (see col. 7, lines 10-20; see col. 7, lines 29-42; see col. 7, lines 24-27) A function to initiate or update subscription access (set process rights mode), copyright process rights, information. Administration of subscription access information is completed using a visual (information display type) web based interface. “*The user authentication daemon 58 also processes the subscription access server’s request for online subscription application and online subscription activation.*”)

Regarding Claims 14 (Currently Amended), **32** (New), Gregg discloses the data processing apparatus according to claim 1, wherein said display unit is operable to display on the screen the process right stored in said right information storage unit by switching a display method based on a set display mode. (see col. 7, lines 29-42: A function to initiate or update subscription access (set display rights mode), copyright process rights, information. The process right information database is updated. “*The*

subscription access server 34 authorizes each web transaction that involves subscription access protected content and does so by communication with the subscribers and implements intellectual property protection")

Regarding Claims 15 (Currently Amended), **33** (New), Gregg discloses the data processing apparatus according to claim 1, wherein said control unit is operable to output a warning signal when determining that the instruction is not to be executed, and said display unit is operable to display a warning screen based on the warning signal. (see col. 21, lines 7-10: If a copyright process instruction (save, delete or cut, copy) is not allowed, an indicative message is displayed. *"If it does, then the cut/copy/paste function is invoked (block 420) and if not, results in the copyright notice prohibiting this action (block(422))."*)

5. Claims **3 - 10, 18, 21 - 28, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregg-Levine** as applied to claims 1, 19 above, and further in view of **England et al.** (US Patent No. 6,330,670).

Gregg discloses a computer security system controlling access to copyrighted content and the capability to perform process rights actions (i.e. copy, save, delete) for the protected content. (see Gregg col. 2, lines 9-13: *"...provide such a system that has the capability of preventing content from being copied by controlling the functionality of a client application, such as a web browser, while displaying protected contents ...*

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copyrighted content, for example, can be identified and the client application can be controlled to preclude such functionality as cut and paste, copy or print.”)

Regarding Claim 3 (Currently Amended), Gregg does not disclose the capability to copy data to a removable medium. However, England discloses the data processing apparatus according to claim 1, wherein said process execution unit includes a data copy unit operable to copy the data stored in said data storage unit to a removable storage medium and to delete the data copied to the storage medium based on a determination by said control unit. (see Gregg col. 19, lines 61-66: If the copyright protected contents are designated as copy protected, then the contents cannot be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). If the user has the permission to copy the copyright protected contents, then the contents can be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). *“In accordance with still another important aspect of the present invention, the system is adapted to provide copyright or intellectual property protection ... if the content is designated as being protected, a user will be prevented from copying the content in any of the traditional ways.”*) (see England col. 6, lines 18-23: *“The computer 20 further includes a hard disk drive 27 for reading from and writing to a hard disk, not shown, a magnetic disk drive 28 for reading from or writing to a removable magnetic disk 29, and an optical disk drive 30 for reading from or writing to a removable optical disk 31 such as a CD ROM or other optical media.”*)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregg to have the capability to copy data to a removable

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medium. One of ordinary skill in the art would be motivated to modify Gregg in order to enhance the operation of a contents management system using process rights as taught by England. (see England col. 4, lines 31-35: "*... digital rights management system ... protects content downloaded to a general-purpose personal computer and does so within the framework of a standard operating system, alleviating the need for additional and specialized hardware.*")

Regarding Claim 4 (Previously Presented), **22** (Previously Presented), Gregg does not disclose a display screen to display storage medium information on the screen. However, Levine discloses the data processing apparatus according to claim 3, wherein said right information storage unit is operable to store storage medium information for identifying the storage medium, and said display unit is operable to display the said storage medium information on a screen. (see Levine col. 2, lines 39-42; col. 3, line 65 - col. 4, line 6; col. 7, lines 39-45: customized display, icons representing application initiation when selected)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregg to enable a display unit to display one or more icons indicating application execution as taught by Levine. One of ordinary skill in the art would be motivated to employ Levine in order to optimize techniques for the creation and access to customized control interfaces for users. (see Levine col. 1, lines 7-9: "*... user interface, in particular, to a simplified technique of creation, storage and access to multi-level customized control interfaces ...*")

Regarding Claims 5 (Currently Amended), **23** (New), Gregg discloses the data processing apparatus according to claim 4, wherein said display unit is operable to display the storage medium information of the storage medium on the screen when said input unit selects the data copied to the storage medium. (see col. 21, lines 20-22: The display window is setup using established web browser icons and links to successive web pages or program executions (process right options) that are invoked using a pointing device (such as a mouse device). "... *HTML contents are displayed (block 438) and the user chooses one of the print, save or cut/copy/paste options (block 440).*")

Regarding Claims 6, 7 (Currently Amended), **24, 25** (New), Gregg discloses the data processing apparatus according to claim 4, wherein said storage medium information is a storage medium identifier which is unique to the storage medium and which is assigned to the storage medium for identification. (see col. 31, lines 28-31: Subscription ID indicates a unique identifier for each subscription access, copyrighted process right. "*Unique ID assigned to each subscription defined for a company in the subscription access server system.*")

Regarding Claims 8 (Currently Amended), **26** (New), Gregg discloses the data processing apparatus according to claim 3, wherein said control unit is operable to output a warning signal when determining that the instruction for copying the data to the

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storage medium is not to be executed; and said display means unit is operable to display a warning screen based on the warning signal. (see col. 21, lines 34-37: If the process right instruction cannot be implemented, then a indicative (instruction is not allowed) message is displayed. *"Finally, if the message was a cut/copy/paste message, the program determines if the level permits this to be done (block 464) which if it does permit it (block 466) or if not, displays a message indicating as much."*)

Regarding Claims 9 (Currently Amended), **27** (New), Gregg discloses the data processing apparatus according to claim 8, wherein said display unit is operable to make a display on the warning screen for prompting a user to obtain a process right that is required for copying the data copy. (see col. 5, lines 24-27; see col. 35, lines 15-21: Modifications and extensions can be implemented to enhance and improve the operation of defined functions. When a warning screen is displayed for a non-allowed instruction, the invention is enhanced to display a message and update the process right information. The web based visual interface that administers and maintains subscription profiles interacts with this automated update procedure. *"The server 34 also includes a site administration software program that provides a web based visual interface to administer the session manager and maintain subscription profiles."*)

Regarding Claims 10 (Currently Amended), **28** (New), Gregg discloses the data processing apparatus according to claim 3, wherein said control unit is operable to

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output a warning signal when determining that the instruction for deleting the data from the storage medium is not to be executed, and said display unit is operable to display a warning screen based on the warning signal. (see col. 21, lines 34-37; see Fig. 26-422: If the "cut" option (delete) cannot be completed due to process rights, an indicative message is displayed. *"... if the message was cut/copy/paste message, the program determines if the level permits this ... if not, displays a message indicating as much."*)

Regarding Claims 18 (Previously Presented), **34** (New), Gregg does not disclose the capability to copy copyrighted content to a removable medium. However, England discloses the data processing apparatus according to claim 1, wherein the process right comprises a check-out right representing a right to copy the data stored in said data storage unit to a removable storage medium, and said display unit is operable to display at least one "check-out is possible", "during check-out" and "check-out is impossible" with respect to the check-out right. (see England col. 6, lines 18-23: *"The computer 20 further includes a hard disk drive 27 for reading from and writing to a hard disk, not shown, a magnetic disk drive 28 for reading from or writing to a removable magnetic disk 29, and an optical disk drive 30 for reading from or writing to a removable optical disk 31 such as a CD ROM or other optical media."*)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Gregg to have the capability to copy copyrighted content to a removable medium. One of ordinary skill in the art would be motivated to modify Gregg

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in order to enhance the operation of a contents management system using process rights as taught by England. (see England col. 4, lines 31-35: "*... digital rights management system ... protects content downloaded to a general-purpose personal computer and does so within the framework of a standard operating system, alleviating the need for additional and specialized hardware.*")

Regarding Claim 21 (Previously Presented), Gregg does not disclose the capability to copy copyrighted content to a removable medium. However, England discloses the data processing apparatus according to claim 19, wherein said process execution means includes data copy means for copying the data stored in said data storage means to a removable storage medium and deleting the data copied to the storage medium based on a determination by said control means. (see Gregg col. 19, lines 61-66: If the copyright protected contents are designated as copy protected, then the contents cannot be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). If the user has the permission to copy the copyright protected contents, then the contents can be copied using traditional means (PC copy data to hard drive, floppy drive, CD drive). "*In accordance with still another important aspect of the present invention, the system is adapted to provide copyright or intellectual property protection ... if the content is designated as being protected, a user will be prevented from copying the content in any of the traditional ways.*") (see England col. 6, lines 18-23: "*... a magnetic disk drive 28 for reading from or writing to a removable magnetic*

disk 29, and an optical disk drive 30 for reading from or writing to a removable optical disk 31 such as a CD ROM or other optical media.")

Allowable Subject Matter

Claim 34 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyung H. Shin whose telephone number is (571) 272-3920. The examiner can normally be reached on 9 am - 7 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KHS

Kyung H Shin
Patent Examiner
Art Unit 2143

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11/28/05



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